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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,963	09/20/2001	Hiroshi Sumiyama	018775-842	1910

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EXAMINER

HANG, VU B

ART UNIT PAPER NUMBER

2625

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/955,963	Applicant(s) SUMIYAMA ET AL.	
	Examiner Vu B. Hang	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/19/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This office action is responsive to the following communication: Amendment filed on 03/21/2006.
- Claims 1-20 are pending in the application.

Response to Arguments

Applicant's arguments, concerning an "apparatus incorporating no image memory" (see Page 14), filed 03/21/2006, with respect to the rejections of **Claims 1, 9, and 17** under 35 U.S.C. 102 (B) have been fully considered and are persuasive. Therefore, the previous rejections of the above claims have been withdrawn. However, upon further consideration, new ground of rejections is made in view of Aina (US Patent 5,663,800).

Applicant's arguments with respect to "a key for generating a signal and a reception means for receiving the image data stored in the image memory in accordance with the signal" found in **Claims 1, 9, and 17** have been considered but are not persuasive in view of Nishiyama et al. (US Patent 6,067,168). Nishiyama discloses a key for generating a signal in response to operation by a user (see Fig. 6 - Fig.9 and Col.10, Line 21-58) and a reception means for receiving the image data stored in the image memory in accordance with the signal (see Fig. 6 - Fig.9 and Col.10, Line 21-58). It is clear that the user interface of Fig.6 – Fig.9 contains user operation keys for performing image processing and retrieving image data in response to operations by the user. The presence of the "Next" and "Previous" keys suggests that image data will be retrieved when pressed by a user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ainai (US Patent 5,663,800) in view of Nishiyama et al. (US Patent 6,067,168).

Regarding **Claims 1 and 17**, Ainai discloses an image forming apparatus incorporating no image memory (see Fig.3 and Col.2, Line 17-22), comprising:

an input device for receiving image data as an input (see Fig.3 (1) and Col.6, Line 59-66);
transfer means for transferring the image data received by the input device to an image memory of a memory incorporating apparatus connected to the input device via the network (see Fig.3 (1,6,7) and Col.3, Line 45-50); and
a printing device for forming an image with use of the image data received by the reception means (see Fig.(3)).

Ainai fails to disclose a key for generating a signal and a reception means for receiving the image data stored in the image memory in accordance with the signal. Nishiyama, however, discloses a key for generating a signal in response to operation by a user (see Fig. 6 - Fig.9 and Col.10, Line 21-58) and a reception means for receiving the image data stored in the image memory in accordance with the signal (see Fig. 6 - Fig.9 and Col.10, Line 21-58).

Ainai and Nishiyama are combinable because they are from the same field of endeavor, namely image processing systems. At the time of the invention, it would have been obvious for

one skilled in the art to include to the apparatus a key for generating a signal in response to operation by a user and a reception means for receiving the image data stored in the image memory in accordance with the signal. The motivation would be to include a user interface for sending print commands to the image-forming device. With the user interface an operator can provide manual print settings to the image-forming device.

Regarding **Claims 2 and 10**, Ainaï further discloses a retrieval means for retrieving the image data in the memory of the memory-incorporating apparatus connected to the network (see Fig.3 (6,7), Col.3, Line 18-29 and Col.3, Line 45-50).

Regarding **Claims 3 and 11**, Ainaï discloses the transfer means of Claim 2 but fails to disclose a transfer means for transferring the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval means. Nishiyama, however, discloses a transfer means for transferring the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval means (see Col.2, Line 66 – Col.3, Line 3). At the time of the invention, it would have been obvious for one skilled in the art to include a means for transferring the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval means. The motivation would be to provide an image data storage means in which the stored image data can be retrieved for repeat printings. The storage means would benefit printings in which the same image data are repeatedly used.

Regarding **Claims 4 and 12**, Nishiyama further discloses a warning device for informing a user that the retrieval means cannot identify any memory-incorporating apparatus (see Col.18, Line 47-49). At the time of the invention, it would have been obvious for one skilled in the art to include the warning device. The motivation would be to detect the presence of image data to be

printed. A user trying to perform a printing operation should be notified when there are no image data present to be printed.

Regarding **Claims 5 and 13**, AinaI further discloses a transfer instructions means for inputting a data transfer instruction in response to operation by a user (see Fig.1 (1,6) and Col.6, Line 63-66), wherein the retrieval means retrieves the image data in the image memory of the memory-incorporating apparatus when the data transfer instruction is inputted (see Fig.1 (1,6), Col.3, Line 18-29 and Col.3, Line 45-50).

Regarding **Claims 6 and 14**, Nishiyama further discloses the key is displayed on a display device (see Fig.6 – Fig.9 and Col.4, Line 46-48).

Regarding **Claims 7 and 15**, Nishiyama further discloses a user interface display that identifies the memory-incorporating apparatus (see Fig.8a and Col.11, Line 7-12) and determining whether the memory-incorporating apparatus is able or unable to store image data request (see Fig.27 (118) and Col.32, Line 47-55). AinaI and Nishiyama, however, fail to disclose “not displaying the key when the retrieval means identifies a no-memory-incorporating apparatus”. Official notice is taken that it is well known in the art at the time of the invention to remove a key or menu after the option is no longer available. It would have been obvious to remove the key if the retrieval means identifies a no-memory-incorporating apparatus. The motivation would be to minimize confusions and time wasted for viewing options that are no longer in use.

Regarding **Claims 8 and 16**, Nishiyama further discloses the key is displayed on the display device during or after image forming operation by the printing device with use of image data inputted by the input device (see Fig.17 (121a) and Col.4, Line 43-51).

Regarding **Claim 9**, Ainaï discloses an image forming apparatus incorporating no image memory (see Fig.3 and Col.2, Line 17-22), comprising:

a buffer for holding the image data created by the reading device (see Fig.3 (5a-c) and Col.3, Line 23-29);

a printing device for forming a copy of the image document on a sheet of paper based on the image data held in the buffer (see Fig.3 (3));

a transfer means for transferring the image data stored in the buffer to an image memory of a memory-incorporating apparatus connected to a network via the network; and a control means for controlling the printing device which forms an image with use of the image data received by the reception means (see Fig.3 (1,6,7) and Col.3, Line 45-50); and

a control means for controlling the printing device, which forms an image with use of the image data received by the reception means (see Fig.3 (1,3,6) and Col.6, Line 59-66).

Ainaï fails to disclose a reading device, a key for generating a signal and a reception means for receiving the image data stored in the image memory in accordance with the signal. Nishiyama, however, discloses a reading device for creating data by reading an image document (see Fig.11 (91-93) and Col.12, Line 56-62), a key for generating a signal in response to operation by a user (see Fig. 6 - Fig.9 and Col.10, Line 21-58) and a reception means for receiving the image data stored in the image memory in accordance with the signal (see Fig. 6 - Fig.9 and Col.10, Line 21-58).

Ainaï and Nishiyama are combinable because they are from the same field of endeavor, namely image processing systems. At the time of the invention, it would have been obvious for one skilled in the art to include to the apparatus a key for generating a signal in response to

operation by a user and a reception means for receiving the image data stored in the image memory in accordance with the signal. The motivation would be to include a user interface for sending print commands to the image-forming device. With the user interface an operator can provide manual print settings to the image-forming device. It is further obvious to include a reading device for creating data for the purpose of scanning the image data and storing the image data in a memory component for later retrieval.

Regarding **Claim 18**, the rational provided in the rejections of Claim 9 are incorporated herein.

Regarding **Claim 19**, the rational provided in the rejections of Claim 1 are incorporated herein.

Regarding **Claim 20**, the rational provided in the rejections of Claim 9 are incorporated herein.

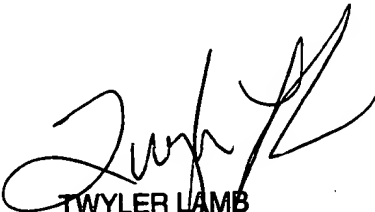
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571) 272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Vu Hang
Assistant Examiner



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SUPERVISORY PATENT EXAMINER